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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,329	08/29/2001	Charles Buckley	BLD920010026US1	6579
23550 7590 12/19/2008 HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207				
EXAMINER STRANGE, AARON N				
ART UNIT		PAPER NUMBER		
2453				
NOTIFICATION DATE		DELIVERY MODE		
12/19/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

09/941,329

Applicant(s)

BUCKLEY ET AL.

Examiner

AARON STRANGE

Art Unit

2453

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner would like to note that the present application has been reassigned to a new Examiner.

Response to Arguments

2. With regard to claim 1, and Applicant's assertion that the combined references fail to teach or suggest that "both the hardware and software layer of the console device can be accessed without the requirement for an additional hardware dongle or an additional signal device transmitter" since the "firmware of Chang constitutes a hardware dongle" (Remarks 11-12), it is noted that this issue was decided in "Decision on Appeal" mailed 8/4/2008 (p. 9), which agreed that Chang's firmware is not a hardware dongle. Accordingly, this argument is not persuasive and will not be addressed in further detail.

3. With further regard to claim 1, and Applicant's assertion that the references fail to teach "that the method is adapted to access the console device in the case that the console device has completely failed (Remarks 12), it is noted that this argument relies upon a newly added limitation that is not supported by the specification. Claim 1 has been rejected under 35 U.S.C. § 112, first paragraph, below.

4. Applicant's arguments with respect to claims 2-26 mirror or depend upon the arguments presented with respect to claim 1. Those arguments are unpersuasive for at least the reasons discussed above.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. With regard to claim 1, the limitation "wherein the method is adapted to access the console device in the case that the console device has completely failed" is not described in the specification.

The specification describes that accessing the console device at the "software level" allows access to the operating system and applications of the console device so that users "can collaborate on projects and/or troubleshoot the software in console device 32A1" (Spec. 15, ll. 10-13). It would have been clear to one of ordinary skill in the

art that a user could access a device for the purpose of collaborating on projects or troubleshooting software on a device that had completely failed, since a completely failed device would be unable to run the software to be accessed.

The specification additionally describes accessing the "hardware of the console device". This mode allows the user to perform operations such as "access BIOS functions", "send special hardware signals, HALT, reboot, [and] electrical power control (on/off)" (Spec. 15, ll. 20-22). Again, it would have been clear to one of ordinary skill in the art that a user could not access a device to access BIOS functions, send hardware signals, or reboot the device if it had completely failed. In fact, Applicant's own arguments acknowledge that a device capable of booting "can not have completely failed" (Remarks 13).

At no point does the specification describe accessing a console device that has completely failed. In contrast, the specification describes accessing a device to perform limited functions and troubleshoot software on the device, operations that are not possible on a completely failed device.

8. Independent claims 7, 9, 12, 20 and 26 contain a substantially identical limitation, and are rejected under the same rationale.

9. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 19, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. With regard to claim 26, the claim is directed to a "program product stored on a computer readable medium ... which, when executed, comprises" a plurality of "program code" elements. The current language of the claim suggests that the program product contains nothing until "executed", making it unclear if the claimed "program code" is intended to be part of the program product stored on the recordable medium or generated at some later time. Appropriate correction is required.

Claims 19 and 25 contains similar language ("the program product, when executed, comprises") and are rejected under the same rationale.

Claim Rejections - 35 USC § 103

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. While the prior art of record fails to teach accessing a console device that has completely failed, it does teach a method/system/program product that accessing a

partially failed console device for the purpose of performing limited control of the hardware and software of device, including the BIOS and OS files. The prior art of record teaches a system commensurate in scope with Applicant's *disclosed* invention.

15. The rejection set forth in the Office action mailed 4/7/06 (§5-20) remains applicable to the disclosed invention, and would be reinstated should the claims be amended or interpreted to be directed to a method to access a console device that has *any* functionality (i.e., a device that has not *completely* failed).

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Examiner, Art Unit 2453